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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,676	02/22/2005	Terje Skaug	915-001.036	2315
4955 7590 10/15/2009 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468				
EXAMINER KARIM L PEGEMAN				
ART UNIT 2629		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/501,676

**Applicant(s)**

SKAUG, TERJE

**Examiner**

PEGEMAN KARIMI

**Art Unit**

2629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on 09/21/2009 has been entered and considered by the examiner.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and further in view of Lee (U.S. Pub. No. 2003/0016417).

**As to claim 1**, Miyashita teaches an apparatus (100, which is a device for communication), comprising:

an already existing electronic communication or player device having a screen display (the existing electronic communication or player communication or player device has a display screen 101), and

one or more pointing device components integrated into the already existing electronic communication or player device (the pointing device 105 is added to the existing electronic communication or player device 100),

wherein said one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions (the already existing electronic communication or player devices main function is a mobile telephone, col. 5 lines 2-7),

an auxiliary function as a pointing device (the auxiliary function is the mouse functionality of 105, col. 5, lines 8-11),

Miyashita does not mention the already existing electronic communication or player device to act together with an external electronic communication or player screen device. Steele teaches the already existing electronic communication or player device (400a) to act together with an external electronic communication or player screen device (416a), which makes use of the pointing device (108a), (col. 6, lines 48-49) and wherein the external electronic communication or player screen device is other than the screen display of the already existing electronic communication or player device. (the screen 101 on Miyashita's is different than the screen 416a in Steele because one is attached to the already existing electronic communication or player device and the other is not attached to the already existing electronic communication or player device and is considered an external display screen). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the remote control system 400a of Steele to the telephone set main body of Miyashita which will result in a useful and tangible result, wherein the user can use the same device for multiple usage such as a telephone and a cursor positioning device to select an item on the view screen.

Miyashita and Steele do not mention the pointing device being configured to operate independent of a functionality of the existing electronic communication or player device.

Lee teaches the pointing device (laser pointer) being configured to operate independent of a functionality of the existing electronic communication or player device (mouse, wherein the casing 2 is considered a generic optical mouse [0031], lines 2-3), (the laser guiding device can fit on an end face of the device wherein the ON/OFF is controlled by a push button switch, wherein the functionality of the laser is separate from the functionality of the mouse ([0014])). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the laser guided device separate from the functionality of the mouse of Lee to the apparatus of Miyashita as modified by Steele because to provide a wireless pointing and remote controlling device for briefing, which may cooperate with a conventional laser-guiding device for aiding a briefing operation ([0009]).

**As to claim 2,** Miyashita does not mention an optical or radio transmission connection with the external electronic communication or player device. Steele teaches the already existing electronic communication or player device (400a) comprises optical or radio transmission means configured to establish a wireless connection with the external electronic communication or player screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

**As to claim 3,** Steele the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

**As to claim 4,** Miyashita teaches the pointing device components (109, 107, and 108) are integrated in an auxiliary unit (105), said auxiliary unit is releasably mounted to the already existing electronic communication or player device (as can be seen in Fig. 2 the auxiliary unit is releasable from the already existing electronic communication or player device 100 by portions 125 and 126, col. 7, lines 5-9) in such a manner that the auxiliary unit can be released and act as a-the pointing device separately from the already existing electronic communication or player device (as can be seen in Fig. 2 the auxiliary unit 105 is separated from the already existing electronic communication or player device 100 and is used as a mouse).

**As to claim 5,** Steele teaches the auxiliary unit further comprises optical or radio transmission means (infrared connection), said optical or radio transmission means is configured to establish a wireless connection with the external electronic communication or player screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

**As to claim 6,** Miyashita teaches the auxiliary unit is a battery pack of the already existing electronic communication or player device (col. 6, lines 9-12).

**As to claim 10,** Miyashita teaches the already existing electronic communication or player device (100) is one of the following devices: a mobile telephone, a personal data assistant, a digital audio player and a minidisk player (device 100 is a mobile telephone).

**As to claim 11,** Steele teaches the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

**As to claim 12,** Miyashita teaches the pointing device components (109, 108, and 107) are configured in a body of the already existing electronic communication or player device (the components 107-109 are configured in the already existing electronic communication or player device 100 via 105) in such a manner that the body is suitable for contact with a user's palm (It can be seen in Fig. 1 that the mobile telephone device is used by a user and requires a user to use the telephone with his/her hand).

**As to claim 13,** Miyashita teaches the pointing device components (107-109) are configured to perform functionality of a mouse unit (col. 6, lines 8-11).

**As to claim 14**, Miyashita teaches the pointing device components (107-109) are configured in a body of the already existing electronic communication or player device (the components are configured in the already existing electronic communication or player device 100 via 105) in such a manner that the body appears to a user like a body of a mouse unit (the body 105 configured in the already existing electronic communication or player device 100 is a mouse having left and right buttons 107 and 108 and rotary wheel 109).

#### ***Response to Arguments***

4. Applicant's arguments filed 09/21/2009 have been fully considered but they are not persuasive.

Applicant argues that the cited reference at least fail to disclose or suggest that the pointing device is configured to operate independent of a functionality of the existing electronic device, wherein claim 1 is amended to clarify that the electronic device is "an already existing electronic communication or player device".

Examiner respectfully disagrees because the invention of Miyashita uses two devices, which are a portable phone and a mouse. The remote control system of Steele can be added to the portable telephone set body 100 of Miyashita wherein the user can use the device 100 primarily as a telephone and also use the device 100 as a pointing device by using the added functionality of remote control system 400a. Therefore a user can use the mobile device 100 as a communication device and have an attached



remote control system 400a attached to the mobile device similar to the mouse 105.

The user then can use the mobile device for communication purposes and also control a cursor on the screen of an external device independently.

The term "communication device" is a broad term, wherein a portable device, mobile phone, a remote control, or mouse can be considered a communication device because they all communicate with the display or user.

Applicant argues that Lee does not disclose or suggest that the electronic device is a communication or player device. Examiner would like to point out that remote control 1 of Lee is a communication device, wherein the device is communicating with a computer 3 via a receiver 2. Therefore Miyashita, Steele, and Lee teach a communication device.

Applicant argues that the device of Lee is not compatible with Miyashita and Steele. The prior art references of Miyashita and Steele teach the functionality of a telephone device and an auxiliary device such as a pointing device combined in a portable telephone set. The two devices work independently from each, however, in order to show this functionality in better detail the prior art reference of Lee has been added, which teaches a laser pointer (pointing device) can be installed in the main body of the mouse. This laser pointer (pointing device) is controlled by the control switch therefore one skilled in the art may add the laser emitter of Lee to the mouse section 105 of Miyashita in order for the portable telephone set to have an auxiliary function of pointing device. Since the laser projection is independent from the portable telephone

set therefore the limitation of "the pointing device is configured to operate independent of a functionality of the existing electronic device" is met.

Applicant argues that the main function of the device of Lee is to be the pointing device. The pointing device wherein the device is used as a mouse can be considered as the main function, wherein the device is an already existing communication device because the device 1 is communicating with the computer 3. The auxiliary function is the laser pointer.

Applicant argues that Lee teaches away from the idea of the invention, since according to the invention performing the auxiliary function does not exclude the simultaneous operation of the main function.

The device 100 of Miyashita in combination with the device 400a of Steele or the laser pointer of Lee can have independent functionality, wherein the user can use the telephone 100 and at the same time use the remote control system 400a of Steele wherein the user can move the cursor on the screen 416a by moving the cursor pointing device 108a. The user can also be on the phone 100 and at the same time use the laser pointer or remote control of Lee as an auxiliary function for pointing purposes.

Applicant in claim 1 does not mention the term "simultaneous". Examiner believes that the term "independent" in the limitation of "said pointing device being configured to operate independent of a functionality of the existing electronic communication device" is met because the electronic communication device 100, wherein the user can use to communicate is independent from the device 400a of Steele or laser pointer 1 of Lee,

wherein the user does not use the functions of one device to operate another. Therefore the devices are operating independent from each other.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Horiki (U.S. Patent No. 6,943,774) teaches a mobile phone having a pointing device disposed on the other main surface of the main body.

### ***Inquiry***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 9:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/  
Examiner, Art Unit 2629  
October 7, 2009

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